

**REMARKS****I. IN THE OFFICE ACTION**

Claims 1-4 and 9 stand rejected under the provisions of 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,298,281 issued to Lowther. Office Action, page 3.

Claims 5-8 and 10-11 stand rejected under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,298,281 issued to Lowther. Office Action, page 4.

Claims 1-4 and 10 stand rejected under the provisions of 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over European Patent Application Publication No. 145,266 in the name of Costain Streeter Lining Ltd. Office Action, page 5.

Claims 5-9 and 11 stand rejected under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over European Patent Application Publication No. 145,266 issued to Costain Streeter Lining Ltd. Office Action, page 6.

Claims 1-4 and 10 stand rejected under the provisions of 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,092,265 issued to Hughes et al. Office Action, page 6.

Claims 5-9 and 11 stand rejected under the provisions of 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,092,265 issued to Hughes et al. Office Action, page 8.

## II. DISCUSSION OF REJECTIONS

### A. Standard for Anticipation

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, it is not enough that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Id.; Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added). Further, under 35 U.S.C. § 102, anticipation requires that the prior art reference “must be enabling, thus placing the allegedly disclosed matter in the possession of the public.” *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986). In this regard, the Federal Circuit has stated that “[a]n anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545 (Fed. Cir. 1998).

### B. Standard for Obviousness

Identification in the prior art of each individual part claimed in a patent is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant. *In re Kotzab*, 217 F.3d at 1370. Even when obviousness is based on a single prior art

reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Id.* The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *Id.* In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *Id.* The test for an implicitly showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *Id.* Whether the Board of Patent Appeals and Interferences relies upon an express or an implicit showing, it must provide particular findings related thereto. *Id.* Broad conclusory statements standing alone are not "evidence." *Id.* (quotes in the original).

### C. Claim Rejections Based Upon Lowther

Lowther discloses methods of treating the interior wall of a conduit by using one or more gelatin "pigs" that are passed through the conduit. Col. 1, lns. 6-13; Col. 2, lns. 29-31; Col. 4, lns. 17-22. Therefore, the substance applied to the interior wall of the conduit, i.e., the gelatin, is present on the "pig" and no transmission lines, reservoirs or other structures are disclosed, taught or suggested. As noted above, a reference cannot be anticipatory if every limitation of the pending claim is not disclosed in the reference. Further, a reference cannot render a pending claim obvious unless the reference motivates a person skilled in the art to modify the teachings of the reference to meet each limitation in the pending claims. Because Lowther is solely directed to the use of gelatin pigs to transport and apply gelatin to the interior surface of a conduit, Lowther does not disclose, or suggest or teach, each limitation of the pending claims. Instead, Lowther teaches the use of a very specific apparatus, namely, a gelatin pig, without anything more, to apply the gelatin layer to the

interior wall of conduits. By not disclosing, teaching or suggesting every limitation of the pending claims, Lowther does not anticipate or render obvious any of claims 1-11.

Therefore, Applicant respectfully requests that the rejection of claims 1-11 under the provisions of 35 U.S.C. § 102(b) or, alternatively, under the provisions of 35 U.S.C. § 103(a) based upon Lowther be withdrawn.

**D. Claim Rejections Based Upon EP 145, 266**

EP 145,266 discloses a rotary spray device disposed on one or more "sledges" to be "pulled" through manholes and sewer pipes. Abstract; p. 1, lns. 1-5; p. 3, lns. 18-21; p. 5, lns. 5-7; p. 6, lns. 1-4; p. 10, lns. 12-21. Neither pressure containment conduits nor production tubulars are disclosed, taught or suggested. For at least these reasons, EP 145,266 does not anticipate or render obvious the pending claims. Therefore, Applicant respectfully requests that the rejection of claims 1-11 under the provisions of 35 U.S.C. § 102(b) or, alternatively, under the provisions of 35 U.S.C. § 103(a) based upon EP 145,266 be withdrawn.

**E. Claim Rejections Based Upon Hughes**

Hughes discloses an apparatus for applying a coating to the interior surface of a cavity of a manhole or potable water conduits. Col. 1, lns. 24-50; Col. 2, lns. 59-61. The cavity is large enough to permit a person to be present in the cavity, however, the invention disclosed, taught, and suggested in Hughes permits the person to be absent from the cavity. Col. 2, lns. 40-56; Col. 3, lns. 19-24. Like EP 145,266, Hughes does not disclose, teach, or suggest pressure containment conduits or production tubulars. In fact, the teachings of Hughes are directed to "cavities" that permit a person to be physically present in the cavity. In other words, Hughes does not disclose, teach, or suggest any system for use in small conduits that do not permit physical access by a person.

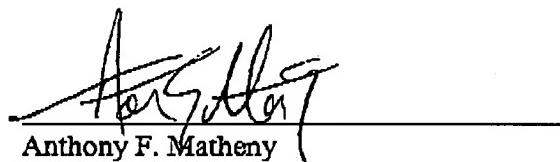
For at least these reasons, Hughes does not anticipate or render obvious the pending claims. Therefore, Applicant respectfully requests that the rejection of claims 1-11 under the provisions of 35 U.S.C. § 102(b) or, alternatively, under the provisions of 35 U.S.C. § 103(a) based upon Hughes be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests that the amendment to claim 1 be entered and that the rejections of claims 1-11 be withdrawn. In order to expedite the examination of this application, Applicant requests the Examiner to contact the undersigned at (713) 220-4168 to discuss any matters that can be resolved by telephone.

Respectfully submitted,

Date: December 21, 2004



Anthony F. Matheny  
Reg. No. 43,778  
Customer No. 31248  
ANDREWS & KURTH L.L.P.  
600 Travis, Suite 4200  
Houston, Texas 77002  
(713) 220-4168

Attorney for Assignee